

**REMARKS**

**Status Of Application**

Claims 1-30 and 33-41 are pending in the application; the status of the claims is as follows:

Claim 18 is rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite for failing to point out and claim the subject matter of the invention.

Claims 1-4, 6-8, 12, 13, 21, 23-25 and 35-39 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Patent No. 2003/0208434 to Posner et al ("Posner"), in view of U.S. Patent No. 6,330,542 to Sevcik et al ("Sevcik").

Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Posner in view of Sevcik, in further view of U.S. Patent No. 6,397,197 to Gindleperger ("Gindleperger").

Claims 11, 22 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Posner in view of Sevcik, in further view of U.S. Patent No. 6,078,906 to Huberman ("Huberman").

Claims 14-16 and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Posner in view of Sevcik, in further view of U.S. Patent No. 6,671,674 to Anderson et al ("Anderson").

Claim 34 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Sevcik in view of Posner.

**35 U.S.C. § 112 Rejection**

The rejection of claim 18 under the second paragraph of 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention, is respectfully traversed based on the following.

Claim 18 recites that the raw material component of the estimated prices is shielded from the first and second printers. While the printers indeed provide the system with a price list, the price list may not include the cost of raw materials. In this case, the invention as recited in claim 18 can shield the raw material pricing from the first and second printers.

Thus, claim 18 particularly points out and distinctly claims the invention.

Accordingly, it is respectfully requested that the rejection of claim 18 under the second paragraph of 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention, be reconsidered and withdrawn.

### **35 U.S.C. § 103(a) Rejections**

Claims 1-4, 6-8, 12, 13, 21, 23-25 and 35-39 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Patent No. 2003/0208434 to Posner, in view of U.S. Patent No. 6,330,542 to Sevcik.

Claim 1 requires, *inter alia*,

- calculating a first estimated price for said print job with respect to a first printer based on pricing information provided by said first printer for each of said components thus specified;

- calculating a second estimated price for said print job with respect to a second printer based on pricing information provided by said second printer for each of said components thus specified;

- informing said buyer of at least a lower of said first and second estimated prices; and

- informing said first and second printers of said set of specifications and an identity of said buyer so as to allow at least one of said first and second printers to contact said buyer to negotiate at least a portion of said set of specifications, wherein said buyer may select one of said first and second printers based on a negotiated set of specifications and a corresponding negotiated price.

Thus, claim 1 requires that the computer system calculate price estimates for the print job with respect to the first and second printers. Since it is the *computer system* which calculates the price estimates and provides at least the lower estimated price to the buyer, the first and second printers are without knowledge as to the specifications of the print job or even the identity of the buyer. Thus, method of claim 1 advantageously provides the first and second printers with the specifications and the identity of the buyer to allow the printers to contact the buyer for negotiation purposes.

In contrast, the invention of Posner “relates to the steps that are performed after a vendor’s proposal in response to an RFP has been received.” (Para 0029). Posner contemplates that the response to the RFP is provided by the vendor. In fact, Posner discloses a “vendor team builder module 112” that enables the vendor’s employees to collaborate in the creation of a proposal. (Para 0022). Since it is the vendor and not the computer system that creates the response to the RFP, the vendor necessarily knows both the specifications of the job and the identify of the buyer. Therefore, there is no need, and in fact Posner does not disclose, suggest or teach the step of informing the first and second printers of the set of specifications and the identity of the buyer as claimed in claim 1 of the present invention.

The Office Action looks to Sevcik to rectify the deficiencies of Posner. Sevcik, however, also does not disclose, suggest or teach the step of informing the first and second printers of the specifications and the identity of the buyer. Instead, the system of Sevcik finds the best printing provider for the job (col. 12, lines 66-67) and puts the job in the job queue for that particular provider (col. 14, lines 63-67). According to Sevcik, other printers are not even given the opportunity to negotiate with the buyer for the buyer’s business.

Thus, the combination of Posner and Sevcik fails to disclose, suggest or teach each and every limitation of claim 1 and therefore fails to render obvious claim 1 or claims 2-4, 6-10, 12-13, 17, and 19-20 which depend therefrom.

Claim 21 requires, *inter alia*,

- calculating a first price estimate based on said first set of component prices; ...
- calculating a second price estimate based on said second set of component prices;
- notifying said buyer of the lower of said first and second price estimates; and
- providing at least one of said first and second printers with said set of specifications and respective ones of said first and second price estimates to allow said at least one of said first and second printers thus provided with said set of specifications to contact said buyer and to negotiate said set of specifications and said respective price estimate.

As discussed above, the system of Posner does not inform the printers of the specifications or the identity of the buyer. Thus, Posner does not disclose, suggest or teach the step of informing at least one of the first and second printers of the set of specifications as claimed in claim 21 of the present invention. Also, as discussed above, the system of Sevcik does not inform the printers of the specifications or the identity of the buyer. Thus, the combination of Posner and Sevcik fails to disclose, suggest or teach each and every limitation of claim 21 and therefore fails to render obvious claim 21 or claims 23-25 and 28-30 which depend therefrom.

Claim 34 requires, *inter alia*,

- a computer program, performed by said computer system, for receiving a set of specifications for said print job, calculating first and second estimated prices for said print job based on said set of specifications and pricing information provided by first and second printers, informing a buyer of said print job of at least a lower of said first and second estimated prices, and informing said first and second printers of said set of specifications and an identity of the buyer;

As discussed above, the system of Posner does not inform the printers of the specifications or the identity of the buyer. Thus, Posner does not disclose, suggest or teach the step of informing at least one of the first and second printers of the set of specifications as claimed in claim 34 of the present invention. Also, as discussed above,

the system of Sevcik does not inform the printers of the specifications or the identity of the buyer. Thus, the combination of Posner and Sevcik fails to disclose, suggest or teach each and every limitation of claim 34 and therefore fails to render obvious claim 34 or claims 35-36 which depend therefrom.

Claim 37 requires, *inter alia*,

informing said printer of said set of specifications and an identity of said buyer so as to allow said printer to contact said buyer to negotiate at least a portion of said set of specifications, wherein said buyer may select said printer to perform said print job based on a negotiated set of specifications and a corresponding negotiated price.

As discussed above, the system of Posner does not inform the printers of the specifications or the identity of the buyer. Thus, Posner does not disclose, suggest or teach the step of informing at least one of the first and second printers of the set of specifications as claimed in claim 37 of the present invention. Also, as discussed above, the system of Sevcik does not inform the printers of the specifications or the identity of the buyer. Thus, the combination of Posner and Sevcik fails to disclose, suggest or teach each and every limitation of claim 37 and therefore fails to render obvious claim 37 or claims 38-41 which depend therefrom.

Accordingly, it is respectfully requested that the rejection of claims 1-4, 6-10, 12-13, 17, 19-21, 23-25, and 35-41 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Posner in view of Sevcik, in further view of U.S. Patent No. 6,397,197 to Gindleperger.

Claim 5 depends from claim 1. As Posner and Sevcik fail to render obvious claim 1, Posner and Sevcik also fail to render obvious claim 5. Moreover, Gindleperger fails to cure the deficiencies of Posner and Sevcik. Gindleperger does not teach, suggest, or disclose informing the printers of the specifications or the identity of the buyer. Thus, a

combination of Posner, Sevcik and Gindleperger fails to disclose every element of the claimed invention.

Accordingly, it is respectfully requested that the rejection of claim 5 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

Claims 11, 22 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Posner in view of Sevcik, in further view of U.S. Patent No. 6,078,906 to Huberman.

Claim 11 depends from claim 1. As Posner and Sevcik fail to render obvious claim 1, Posner and Sevcik also fail to render obvious claim 11. Moreover, Huberman fails to cure the deficiencies of Posner and Sevcik. Huberman does not teach, suggest, or disclose informing the printers of the specifications or the identity of the buyer. Thus, a combination of Posner, Sevcik and Huberman fails to disclose every element of the claimed invention.

Claims 22 and 27 depend from claim 21. As Posner and Sevcik fail to render obvious claim 21, Posner and Sevcik also fail to render obvious claims 22 and 27. Moreover, Huberman fails to cure the deficiencies of Posner and Sevcik. Huberman does not teach, suggest, or disclose informing the printers of the specifications or the identity of the buyer. Thus, a combination of Posner, Sevcik and Huberman fails to disclose every element of the claimed invention.

Accordingly, it is respectfully requested that the rejection of claims 11, 22 and 27 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

Claims 14-16 and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Posner in view of Sevcik, in further view of U.S. Patent No. 6,671,674 to Anderson.

Claims 14-16 depend from claim 1. As Posner and Sevcik fail to render obvious claim 1, Posner and Sevcik also fail to render obvious claims 14-16. Moreover, Anderson fails to cure the deficiencies of Posner and Sevcik. Anderson does not teach, suggest, or

disclose informing the printers of the specifications or the identity of the buyer. Thus, a combination of Posner, Sevcik and Anderson fails to disclose every element of the claimed invention.

Claim 26 depends from claim 21. As Posner and Sevcik fail to render obvious claim 21, Posner and Sevcik also fail to render obvious claim 26. Moreover, Anderson fails to cure the deficiencies of Posner and Sevcik. Anderson does not teach, suggest, or disclose informing the printers of the specifications or the identity of the buyer. Thus, a combination of Posner, Sevcik and Anderson fails to disclose every element of the claimed invention.

Accordingly, it is respectfully requested that the rejection of claims 14-16 and 26 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

Claim 34 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Sevcik in view of Posner.

Claim 34 requires, *inter alia*,

a computer program, performed by said computer system, for receiving a set of specifications for said print job, calculating first and second estimated prices for said print job based on said set of specifications and pricing information provided by first and second printers, informing a buyer of said print job of at least a lower of said first and second estimated prices, and informing said first and second printers of said set of specifications and an identity of the buyer;

As discussed above, the system of Posner does not inform the printers of the specifications or the identity of the buyer. Thus, Posner does not disclose, suggest or teach the step of informing at least one of the first and second printers of the set of specifications as claimed in claim 34 of the present invention. Also, as discussed above, the system of Sevcik does not inform the printers of the specifications or the identity of the buyer. Thus, the combination of Posner and Sevcik fails to disclose, suggest or teach each and every limitation of claim 34 and therefore fails to render obvious claim 34.

Application No. 09/836,691  
Amendment dated February 17, 2006  
Reply to Office Action of November 17, 2005

Accordingly, it is respectfully requested that the rejection of claim 34 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

### **CONCLUSION**

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley Austin LLP's Deposit Account No. 18-1260.

Any fee required by this document other than the issue fee, and not submitted herewith should be charged to Sidley Austin LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.


Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee,



Application No. 09/836,691  
Amendment dated February 17, 2006  
Reply to Office Action of November 17, 2005

and not submitted herewith should be charged to Sidley Austin LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

By:   
Tung T. Nguyen  
Registration No. 42,935  
Attorney for Applicants

DBN:TTN: bar  
SIDLEY AUSTIN LLP  
717 N. Harwood, Suite 3400  
Dallas, Texas 75201  
Direct: (214) 981-3478  
Main: (214) 981-3300  
Facsimile: (214) 981-3400  
February 17, 2006

DA1 345728v.2